

REMARKS

I. Disposition of the Claims

Claims 1-68, 70-74, 76, 77, 79-106, 108 and 109 are currently pending in the application. Claims 6, 9-13, 32-61, and 84-106 were withdrawn, with traverse, subject to a restriction requirement. Claims 69, 75, 78, and 107 were cancelled by Applicant in an earlier Response. Claims 2 and 3 are cancelled herein. Accordingly, after the current submission is entered, claims 1, 4, 5, 7, 8, 14-31, 62-68, 70-74, 76, 77, 79-83, 108, and 109 are currently being prosecuted in the instant application.

II. Rejection Under 35 U.S.C. § 103(a)

The Office has maintained its rejection of claims 1-5, 7-8, 14-31, 62-68, 70-74, 76, 77, 79-83, 108, and 109 as prima facie obvious over the teachings of de la Mettrie (U.S. Pat. No. 6,010,541) in view of those of Rondeau (U.S. Pat. No. 5,879,412). Applicants wish to respectfully point out that the Examiner, as well as Applicants, have mistakenly referred to the de la Mettrie patent in the past as U.S. Pat. No. 6,010,542, when the correct number is U.S. Pat. No. 6,010,541. Applicants respectfully traverse this rejection with respect to all claims for the reasons of record (*See for example*, Response filed June 17, 2002) and for the additional reasons set forth below.

In order to establish a proper prima facie case of obviousness under 35 U.S.C. § 103(a), the Examiner is required to show a suggestion or teaching to combine the cited references in order to arrive at the claimed invention. The Federal Circuit has made it clear that in order to find an invention obvious, the Examiner is required to make **specific** findings, showing that one of skill in the art would have been motivated to combine the references to arrive at the claimed invention. *See, e.g., In re Dembiczak*,

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

50 USPQ2d 1614 (Fed. Cir. 1999). The Examiner has failed to cite such specific teachings and, therefore, has failed to establish a proper prima facie case under 35 U.S.C. § 103(a).

Specifically, the Examiner states that de la Mettrie teaches hair dyeing compositions containing oxidation dye precursors, optional couplers, and at least one nonionic amphiphilic polymer containing a fatty chain and a hydrophilic unit. (*See Office Action*, dated August 13, 2002, p. 3, lines 15-18). Furthermore, the Examiner states that de la Mettrie teaches that "direct dyes, including azo dyes, may be used in admixture with the patentee's oxidation dyes." (*Id.*, p. 4, lines 20-22). The Examiner admits, however, that de la Mettrie does not teach the specific cationic direct dyes recited by the instant claims. (*Id.*, p. 4, lines 7-8).

The Examiner seems to rely on this teaching to suggest that *any* direct azo dyes may be used in the compositions taught by de la Mettrie. The reference, however, contains no such teaching. To the contrary, de la Mettrie teaches that optional ingredients can be selected and added to the disclosed compositions only if they do not adversely affect the advantageous and beneficial properties of the compositions. (Column 8, lines 28-33). This explicit teaching is directly opposite to the Examiner's assertion that because de la Mettrie states that direct azo dyes, for example, may be added to the disclosed compositions, that all azo dyes are therefore taught to be compatible. Instead, de la Mettrie simply suggests that some direct dyes may be compatible, including some azo dyes, but provides no teaching that would have led one skilled in the art to select the *particular* cationic direct dyes recited by the instant claims.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Accordingly, de la Mettrie cannot be relied upon as providing motivation to select the cationic direct dyes of the instant claims.

To make up for this deficiency, the Examiner cites Rondeau. The Examiner states that Rondeau teaches compositions for hair dyeing that contain, among other things, an oxidation base, at least one coupler, at least one oxidizing agent and the claimed cationic direct dyes. (See Office Action, dated August 13, 2002, page 4, lines 9-13). Furthermore, the Examiner states that Rondeau is "relied upon as suggesting that the claimed direct dyes are compatible with de la Mettrie's nonionic polymers." (See *Id.*, p. 4, lines 14-15). Applicants respectfully disagree with this characterization of Rondeau's teachings.

In particular, Rondeau does not state that the disclosed cationic direct dyes are compatible with the nonionic amphiphilic polymer containing at least one hydrophilic unit and at least one unit comprising a fatty chain, as recited in the instant claims. Rondeau instead teaches that the disclosed compositions may contain "anionic, cationic, nonionic or amphoteric polymers." (Column 10, lines 39-47). This general teaching provides no guidance to one skilled in the art as to how to select a particular type of anionic, cationic, nonionic, or amphoteric polymer to use in the disclosed compositions. Rondeau's recitation of a general class of "nonionic polymers," does not render the *specific* types of nonionic polymers, such as those recited in the instant claims, obvious under 35 U.S.C. § 103(a), absent a more specific teaching. As with the de la Mettrie reference, the Examiner takes a very general teaching from Rondeau and extrapolates it to encompass all possibilities. That such extrapolation is error is taught within the Rondeau reference itself. Like de la Mettrie, Rondeau makes it abundantly clear that

not all ingredients taught as optional are compatible with the disclosed compositions. (Column 10, lines 48-53). Therefore, even though general classes of optional ingredients are taught, it is error to assume that all members of a general class will function as intended, absent a teaching that to that effect. Accordingly, it is error to state that Rondeau's general teaching that "nonionic" polymers may be used with the disclosed cationic direct dyes would have led one skilled in the art to select the particular nonionic polymers recited in the present claims.

In summary, the combination of de la Mettrie and Rondeau would not have motivated one of skill in the art to modify their disclosures in order to arrive at the instantly claimed compositions. de la Mettrie does not even mention cationic direct dyes. Nor does de la Mettrie teach that such dyes would be compatible with the compositions disclosed therein. Furthermore, Rondeau does not teach that the disclosed cationic direct dyes would be compatible with the specific type of nonionic amphiphilic polymers recited in the instant claims. Therefore, the combination of de la Mettrie and Rondeau does not render the subject matter of the instant claims obvious under 35 U.S.C. § 103(a). Accordingly, the Applicants respectfully request that the rejection be withdrawn with respect to all claims.

III. Double Patenting

The Examiner has indicated that should Claim 1 be allowed, Claims 2 and 3 will be objected to under 37 C.F.R. 1.75 as being substantial duplicates of each other. Although Applicants disagree with the Examiner, Claims 2 and 3 have been cancelled herein. Therefore, this objection is now moot and Applicants respectfully request that it be withdrawn.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

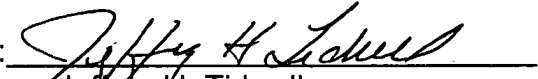
In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 31, 2003

By: 
Jeffrey H. Tidwell
Reg. No. 47,995

488741_1.DOC

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com